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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/976,579	11/24/1997	JAMES D. THORNTON	JAO-34191	2070

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EXAMINER

BROWN, CHRISTOPHER J

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 05/15/2003

29

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

08/976,579

Applicant(s)

THORNTON ET AL.

Examiner

Christopher J Brown

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2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 29-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**1. DETAILED ACTION**

**2. *Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:
4. The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
5. Claim 38 recites the limitation "human readable identifier" in line 1. There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.
6. Claim 32 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for user selectable tokens, does not reasonably provide enablement for selector means. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. The selector means is not enabling because the applicant only discloses a scanner in the instant specification.

**7. *Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:
9. A person shall be entitled to a patent unless –
10. (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**11. Claims 29-38, are rejected under 35 U.S.C. 102(b) as being anticipated by Fajkowski US 5,905246.**

12. As per claim 29, Fajkowski discloses a system for decoding and using tokens encoded in a document, by means of a barcode embedded in a coupon, (Col 3 lines 51-62). The bar codes are decoded by scanning them with a coupon card mechanism, which matches the number of the barcode to coupon data, and displays it on the screen of the coupon card (Col 11 lines 46-56, Fig 4b). The coupon card is a selector that lists decoded tokens, (Col 12 lines 18-25, Fig 4b).

13. As per claim 30, Fajkowski discloses the coupon card allowing a user to select one or more of the decoded tokens, (Col 12 lines 26-32).

14. As per claim 31, Fajkowski discloses the document is a paper document, in this case, a coupon, (Col 4 lines 7-11).

15. As per claim 32, Fajkowski discloses a coupon card to act as a selector means for selecting a token from a list of decoded tokens, (Col 12 lines 18-25, Fig 4b).

16. As per claim 33, Fajkowski teaches that the document is a paper document, in this case, a coupon, (Col 4 lines 7-11).

17. As per claim 34, Fajkowski teaches a method for decoding a user selectable token, encoded into a document, in the instance of a barcode in on a coupon, (Col 3 lines 51-62). Fajkowski discloses creating a list of decoded tokens, (Col 12 lines 18-25, Fig 4b).

18. As per claim 35, Fajkowski discloses a method of selecting a decoded token from a list of decoded tokens, (Col 12 lines 26-32).

19. As per claim 36, Fajkowski discloses a system that reads tokens embedded in a paper document with a scanner, (Col 11 lines 10-16). Fajkowski discloses a coupon card that acts to receive image data from the scanner, identify and decode tokens (bar codes) and display the decoded tokens on a list, (Col 11 lines 10-20, 46-60, Fig 4b). The user is able to select tokens from the list, (Col 12 lines 26-32).
20. As per claim 37, Fajkowski discloses a coupon card capable of generating a list of decoded tokens, (Col 12 lines 43-47, Fig 4b).
21. As per claim 38, Fajkowski discloses the paper document is a coupon, (Col 3 lines 51-55). The examiner takes official notice that coupons have pictures and or text. Fajkowski teaches examination of coupons, which inherently means there is a human readable identifier, (Col 1 lines 43-46).

***22. Claim Rejections - 35 USC § 103***

23. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
- a. A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
- 24. Claims 39-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zdybel US 5,486,686 in view of Laszlo US 5,331,547.**
25. As per claim 39, Zdybel teaches generating at least one user selectable token in the form of a glyph, (Col 8 lines 30-38, 47-50). Zdybel teaches that the glyphs are printed on paper with a human readable identifier of descriptive text, (Col 8 lines 30-38).

26. Zdybel does not teach a token relating to at least one other document, that document being electronic.
27. Laszlo teaches using a token to link a hardcopy document to a related electronic document, (Col 4 lines 31-34, 66-68, Col 5 lines 1-4).
28. It would be obvious to one of ordinary skill in the art to modify Zdybel's token system, with Laszlo's linkage to related documents, because this expands the range of links Zdybel's system can create and use.
29. As per claim 40, Zdybel discloses the human readable identifier to be descriptive text, (Col 8 lines 30-38).
30. As per claim 41, Zdybel discloses a printing at least one token with accompanying human identifier, on paper (Col 8 lines 47-50).
31. As per claim 42, Zdybel does not disclose a token relating to at least one other document, that document being an electronic document.
32. It would be obvious for one skilled in the art to modify Zdyel with Laszlo, who discloses a token that links the paper document to at least one other electronic document, (Laszlo Col 4 lines 31-34, Col 5 lines 66-68, Col 5 lines 1-4). This modification beneficially expands the range of links for Zdybel's tokens.
33. As per claim 43, Zdybel teaches that the token relates to information that simulates the environment described in the paper document, such as the electronic version of the document, (Col 4 lines 64-67, Col 5 lines 1-2).
34. As per claim 44, Zdybel teaches printing at least one encoded token, a glyph, and human readable identifier on paper, (Col 8 lines 30-38, 47-50).

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35. As per claim 45, Zdybel discloses scanning at least one user selectable token, (Col 9 lines 46-53).

*36. Conclusion*

37. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher J Brown whose telephone number is 703-305-8023. The examiner can normally be reached on 8:30-4:30.


38. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 703-305-1830. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7239 for After Final communications.

39. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

40. Christopher J. Brown



41. May 12, 2003



GILBERTO BARRÓN  
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